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[10191/4189]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant(s)	:	Wilhelm FAHRBACH et al.
Serial No.	:	10/538,526
Filed	:	December 12, 2005
For	:	DEVICE FOR A LINE TERMINATION OF TWO-WIRE LINES
Art Unit	:	2819
Examiner	:	Dylan WHITE
Confirmation No.	:	3666

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Date: May 18, 2009 Reg. No. 36,197

Signature: _____
Jong H. Lee

APPELLANTS' REPLY BRIEF IN RESPONSE TO EXAMINER'S ANSWER (UNDER 37 C.F.R. § 41.41)

S I R :

In response to the Examiner's Answer mailed on March 20, 2009 regarding the final rejection of claims 7, 8 and 11-13 in the above-identified application, Applicants submit the following arguments in support of the appeal of the final rejection.

ARGUMENT

A. Rejection of Claims 7, 8 and 13 under 35 U.S.C. §102(e)

Claims 7, 8, and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,700,823 (the "Rahman" reference). Applicants respectfully submit that the rejection is not supported by the actual teachings of the applied reference, for at least the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must **identically disclose** each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of **each and every element of the claim invention, arranged exactly as in the claim**. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy , 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

First, the Rahman reference does not **identically disclose**, or even suggest, the feature that "at least one switching arrangement is configured to **selectively individually separate each of the first and second terminating resistors from the two-wire line**," as recited in claim 7. In this regard, the Examiner has not cited, and cannot cite, any portion of Rahman that **identically discloses** "at least one switching arrangement is configured to **selectively individually separate each of the first and second terminating resistors from the two-wire line**." In an attempt to overcome this fatal deficiency of failing to **identically disclose** the claimed limitation, the Examiner presents **Examiner's own interpretations** of a series of statements found in Rahman as allegedly teaching the claimed limitation at issue. However,

the very fact that the Examiner has to rely on his own **interpretations** attests to the fact that Rahman does not **identically disclose** the claimed limitation at issue.

Second, to the extent the Examiner is relying on his **own interpretations** of a series of statements found in Rahman as allegedly teaching the claimed limitation at issue, the Examiner's asserted interpretations are based on **theoretical possibilities**, not what is **actually disclosed** in Rahman. For example, the Examiner contends that the disclosure of Rahman should be interpreted such that "if the control signal of a transistor represented by a switch can be that of a memory cell output signal or other control signal that it is also understood that two transistors representing two switches **could then be controlled** by two different control signals." (Examiner's Answer, p. 6). However, the obvious and critical flaw in the Examiner's contention is that there is **no actual teaching** in Rahman that two transistors representing two switches **are in fact** controlled by two different control signals, and the mere **theoretical possibility** of this result cannot be equated with actual teaching of the claimed feature. At best, the Examiner's argument is that the cited portions of Rahman somehow **inherently teach** the claimed features, but there is no factual or logical basis to support any such inherent disclosure, i.e., there is no basis in fact and/or technical reasoning to reasonably support the determination that, based on the teachings of Rahman, two transistors representing two switches **would necessarily have to be controlled** by two different control signals.

Third, Applicants explained in the Appeal Brief that Rahman states that "[s]witches 112 are used to connect or disconnect resistors 108 and 110 across lines 106," (Rahman reference, column 3, lines 5 to 6), which statement suggests a switching arrangement that simultaneously and non-individually activates the resistors. In response to this argument, the Examiner contends in the Examiner's Answer that each switch 112 in Rahman is "controlled by a control signal," (p. 7, l. 15; and p. 8, l. 6), and that Rahman "does not state that the same control signal is used for both switches . . . [and] [t]herefore, two switches . . . ***can*** selectively . . . individually separate . . . the first and second terminating resistors" (p. 8, l. 6-10). Once again, the Examiner's assertions attest to a fundamental disregard for the appropriate legal analysis required for the anticipation rejection. The fact that each switch 112 in Rahman is "controlled by a control signal" does not in any way disclose, let alone suggest, that **two different controls signals** are used for the two switches, yet the Examiner is essentially arguing that it is legally sufficient to support an anticipation rejection by the **mere**

theoretical possibility that the two switches **can be** controlled by two different control signals. However, the law is clear that the Examiner cannot support an anticipation rejection by citing a mere theoretical possibility; instead, the Examiner must show that Rahman **identically discloses** (either explicitly or inherently) each and every claim element, which the Examiner has clearly failed to do. To the extent the Examiner is arguing that the Applicants have not definitively shown that **two different controls signals are not used** (or cannot be used) for the two switches in Rahman, Applicants note that it is **not the Applicants' burden to prove that the negative** of the claimed limitation is taught in the prior art, particularly when the Examiner has not shown that the applied prior art actually discloses the claimed feature.

Finally, to the extent the Examiner contends in the last sentence of p. 8 of the Examiner's Answer that the "Rahman reference clearly . . . states that each transistor . . . can be controlled, which would make the control individual to each transistor," this contention ignores the actual claimed limitation. In this regard, Rahman does not state that "each transistor" is individually controlled; instead, Rahman merely states that "[s]witches 112 are used to connect or disconnect resistors 108 and 110 across lines 106." (Rahman reference, column 3, lines 5 to 6). In any case, even if one assumes for the sake of argument that control of **both transistors** somehow makes the control individual to each transistor, this still would not teach or suggest to "**selectively** individually **separate each** of the first and second terminating resistors from the two-wire line," as recited in claim 7.

Therefore, for at least the foregoing reasons, the Examiner has not shown that claim 7 and its dependent claims 8 and 13 are actually anticipated by the Rahman reference, and it is respectfully requested that this anticipation rejection be reversed.

B. Rejection of Claim 11 under 35 U.S.C. §103(a)

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the "Rahman" reference in view of U.S. Patent 6,853,213 (the "Funaba" reference). Since the Examiner's Answer does not present any new arguments with respect to this rejection, Applicants respectfully submit that the combination of the "Rahman" and "Funaba" references does not render obvious claim 11 for the reasons stated in the Appeal Brief.

C. **Rejection of Claim 12 under 35 U.S.C. § 103(a)**

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the "Rahman" reference in view of U.S. Patent 6,324,044 (the "Teggatz" reference). Since the Examiner's Answer does not present any new arguments with respect to this rejection, Applicants respectfully submit that this rejection should be withdrawn for at least the reasons stated in the Appeal Brief.

CONCLUSION

For the preceding reasons, it is respectfully submitted that the rejections of claims 7, 8 and 11-13 should be reversed.

While no fees are believed to be due in connection with this paper, the Office is authorized to charge any fees deemed necessary in connection with this paper to Deposit Account No. **11-0600** of **Kenyon & Kenyon LLP**.

Respectfully submitted,

KENYON & KENYON LLP

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